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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,326	03/16/2001	Jon L. Cook	08049.0006	5362
22852	7590	12/18/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER SALLARD, SHANNON S	
			ART UNIT	PAPER NUMBER
			3628	
			MAIL DATE	DELIVERY MODE
			12/18/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/09,326

Applicant(s)

COOK ET AL.

Examiner

SHANNON S. SALIARD

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-16,54-59,89,90,96,97 and 101-104 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-16,54-59,89,90,96,97 and 101-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Applicant has amended claims 11, 14, 54, 57, 89, 90, 96, and 97. Claims 1-10, 17-53, 60-88, 91-95, and 98-100 have been cancelled. No claims have been newly added. Thus, claims 11-16, 54-59, 89, 90, 96, 97, and 101-104 remain pending and are presented for examination.

Response to Arguments

2. Applicant's arguments, filed 08 July 2009, with respect to the rejection of claims 54-58, 103, and 104 under 35 U.S.C. 101 have been fully considered and are not persuasive. Thus, the rejection of claims 54-58, 103, and 104 under 35 U.S.C. 101 has been withdrawn. However, upon further consideration, a new rejection under 35 U.S.C. 101 has been applied to claims 11-16, 101, and 102.

3. Applicant's arguments with respect to amendments to claims 11, 14, 54, 57, 89, 90, 69, and 97 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 11-16, 101, and 102 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 11-16, 101, and 102 are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process should either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes must positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus the accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). While claims 11-16, 101, and 102 identify the apparatus as a computer in the preamble and a database in the body of the claim, nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See *Benson*, 409 U.S. at 71-72. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one. To permit such a practice would exalt form over substance and permit claim drafters to file the sort of process claims not contemplated by the case law. Cf., *Flook*, 437 U.S. at 593 (rejecting the respondent's assumption that "if a process application implements a principle in some specific fashion, it automatically falls within

the patentable subject matter of § 101," because allowing such a result "would make the determination of patentable subject matter depend simply on the draftsman's art and would ill serve the principles underlying the prohibition against patents for 'ideas' or phenomena of nature."). *see Ex parte Langemyr*. Furthermore, the recitation of a computer apparatus in the preamble is not, in fact, a limitation at all to the scope of the claim, and the claim is directed, in essence, to the method performed by any means. As such, we fail to find that this recitation alone requires the claimed method to include a particular machine such that the method qualifies as a "process" under § 101. We will not allow such a nominal recitation in the preamble to convert an otherwise ineligible claim into an eligible one. *Comiskey*, 499 F.3d at 1380. Since the use of the computer and database is considered to be a nominal recitation of structure, and nominal recitations do not convert an otherwise non-statutory process into a process, claims 11-16, 101, and 102 are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 11-15, 54-58, 89, 90, 96, and 97** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanevsky et al [US 6,285,777] in view of Allen et al [US 5,422,821].

As per **claims 11, 14, 54, 57, 89, 90, 96, and 97**, Kanevsky et al discloses a method comprising the steps of:

obtaining an address of the user from the electronic account [col 5, lines 44-49];
sending the address of the user to a static address database [col 5, lines 55-59],
the static address database contains the standardized physical address of the user,
wherein the standardized physical address conforms to a standard format [col 5, line 49-col 6, line 8; see fig. 5 and descriptions thereof].

Kanevsky et al does not disclose using the address of the user to obtain a delivery point identification key from a master address database; receiving a delivery point identification key from the static address database, the delivery point identification key containing information specifying a location of the standardized physical address within the master address database; and obtaining the standardized physical address from the master address database using the delivery point identification key.

However, Allen et al discloses the known technique of using an address of the user to obtain a delivery point identification key from a master address database (Abstract; col 2, lines 50-65); receiving a delivery point identification key from the static address database, the delivery point identification key containing information specifying a location of the standardized physical address within the master address database (col 6, line 47-col 7, line 5); and obtaining the standardized physical address from the

master address database using the delivery point identification key (col 7, lines 5-20).

This known technique is applicable to the system of Kanevsky et al as they both share characteristics and capabilities, namely, they are directed to delivery of mail items. One of ordinary skill in the art would have recognized that applying the known technique of Allen et al would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Allen et al to the teachings of Kanevsky et al would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such mail address matching features into similar systems. Further, applying the address matching technique of Allen et al to Kanevsky with email addresses stored accordingly, would have been recognized by those of ordinary skill in the art as resulting in an improved system that facilitate address retrieval from a database.

As per **claims 12 and 55**, Kanevsky et al does not disclose wherein the master address database is a United States Postal Service master address database. However, Allen et al discloses wherein the master address database is a United States Postal Service master address database [col 8, lines 19-34]. It would have been obvious to one of ordinary skill in the art to include in the addressing system of Kanevsky et al wherein the master address database is a United States Postal Service master address database as taught by Allen et al since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claims 13 and 56**, Kanevsky et al further discloses wherein the static address database is a United States Postal Service static monolithic address database [col 3, lines 59-61].

As per **claims 15 and 58**, Kanevsky et al further discloses wherein the address database contains a plurality of standardized addresses corresponding to a plurality of users, each standardized address conforming to a standard format [col 6, lines 1-4].

8. **Claims 16, 59, and 101-104** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanevsky et al [US 6,285,777] in view of Allen et al [US 5,422,821] as applied to claim 11, 14, 15, 54, 57, and 58 above, and further in view of Official Notice.

As per **claims 16 and 59**, Kanevsky et al and Allen et al disclose all the limitations of claims 11, 14, 15, 54, 57, and 58. Kanevsky et al further discloses wherein the standard format includes a street and city [see Fig. 5]. Kanevsky et al and Allen et al do not disclose wherein the standard format includes street number, street name, city, state, and ZIP code. However, the Examiner takes Official Notice that it is old and well known at the time of the invention that a standard address of a user contains street number, street name, city, state, and ZIP code. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Kanevsky et al and Allen et al to include wherein the standard format includes street number, street name, city, state, and ZIP code, as known in the art, to advantageously facilitate mail identification.

As per **claims 101-104**, Kanevsky et al and Allen et al do not further disclose wherein the standard format of the standardized physical address comprises one of "delivery point", "plus 4", "5 digit", and "last line" standardization. However, the Examiner takes Official Notice that it is old and well known in the art at the time of the invention for a physical address to include at least one of "delivery point", "plus 4", "5 digit", and "last line". Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Kanevsky et al and Allen et al to include wherein the standard format includes at least one of "delivery point", "plus 4", "5 digit", and "last line", as known in the art, to advantageously facilitate mail identification.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHANNON S. SALIARD whose telephone number is (571)272-5587. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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